



1637

2024738-7030230000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Brian Lentricchia, et al.) Group Art Unit: Not Yet Assigned
Serial No.: 10/053,349) Examiner: Not-Yet-Assigned
Filed: January 15, 2002)
For: NUCLEIC ACID EXTRACTION)
SOLUTION AND USE THEREOF)

)

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AUG 12 2003

TECH CENTER 1600/2900

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with 37 CFR § 1.97 and 1.98, and, the item identified in this Information Disclosure Statement ("IDS") is brought to the attention of the Office. The item listed on the attached form PTO/SB/08A (08-00) is enclosed.

The item identified in this IDS may or may not be "material" pursuant to 37 CFR § 1.56. The submission thereof by Applicant is not to be construed as an admission that any such patent, publication or other information referred to therein is material or considered to be material (37 CFR § 1.97(h)), or even qualifies as "prior art" under 35 USC § 102 with respect to this invention unless specifically designated by Applicant as such.

CERTIFICATE OF MAILING TRANSMISSION
(37 C.F.R. §1.8)

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposit with the United States Postal Services on the date shown below with sufficient postage as "First Class Mail" to addressee in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA22313-1450.

8/5/03
Date of deposit

Carolyn Tobias

Name of Person transmitting Paper

Carolyn Tobias

Signature of Person Depositing Paper

INFORMATION DISCLOSURE STATEMENT FILING PROVISION:

This IDS is believed to be timely in that it is being submitted under 37 CFR § 1.97(b), that is (1) within three months of the filing date of the application, which is not a continued prosecution application filed under § 1.53(d) or (2) within three months of entry of the national stage as set forth in 37 CFR § 1.491; or (3) before the mailing of a first Office action on the merits; or (4) before the mailing of a first Office action after filing a request for continued examination under § 1.114. Thus, no fee is required.

However, if the undersigned is in error in this regard, Applicant respectfully requests that the Office consider this IDS as filed under 37 CFR § 1.97(c), if applicable, and charge the fee due under 37 CFR § 1.17(p) to the deposit account referenced below.

However, if the undersigned is in error in this regard, Applicant respectfully requests that the Office consider this IDS as filed under 37 CFR § 1.97(c), if applicable, and a statement under 37 CFR § 1.97(e) is included below, thus no fee is required.

This IDS is being submitted under 37 CFR § 1.97(c), that is after mailing of a first Office action on the merits, but before a Final Action under 37 CFR § 1.113 or a Notice of Allowance under 37 CFR § 1.311.

The fee due under 37 CFR § 1.17(p) is submitted herewith.

A statement under 37 CFR § 1.97(e) is included below, thus no fee is required. In the event that this IDS is not received before a Final Action or a Notice of Allowance, then Applicant respectfully requests that the Office consider the filing of these papers to be submitted under 37 CFR § 1.97(d) and charge the fee due under 37 CFR § 1.17(p) to the deposit account below.

This IDS is being submitted under 37 CFR § 1.97(d), that is after a Final Action under 37 CFR § 1.113 or a Notice of Allowance under 37 CFR § 1.311, but before payment of the issue fee. A statement under 37 CFR § 1.97(e) is included below. The fee due under 37 CFR § 1.17(p) is submitted herewith.

STATEMENT UNDER 37 CFR § 1.97(e):

Each item contained in this IDS was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this IDS.

No item contained in this IDS was cited in a communication from a foreign patent office in a counterpart foreign application, and, to the knowledge of the person signing this statement after making reasonable inquiry, no item of information contained in this IDS was known to any individual designated in 37 CFR § 1.56(c) more than three months prior to the filing of this IDS.

PAYMENT AND/OR AUTHORIZATION TO CHARGE FEES:

- A check in the amount of _____ is enclosed for the above fee(s).
- Please charge _____ to Deposit Account No. **50-2518** for the above fee(s).

The Commissioner is authorized to charge any fees required by the filing of these papers, and to credit any overpayment to Bingham McCutchen's Deposit Account No. **50-2518**.

Respectfully submitted,

BINGHAM McCUTCHEN LLP

By: DT Burse
David T. Burse
Reg. No. 37,104

Dated: 8-5-03

BINGHAM McCUTCHEN LLP
Three Embarcadero, Suite 1800
San Francisco, CA 94111-4067
(650) 849-4400



Please type a plus sign (+) inside this box →

PTO/SB/08A (08-00)

Approved for use through 10/31/2002. OMB 0651-0031
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE
respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449A/PTO

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(use as many sheets as necessary)

Sheo

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Substitute for form 1449A/PTO		Complete if Known
INFORMATION DISCLOSURE STATEMENT BY APPLICANT		Application Number 10/053,349
		Filing Date 1/15/02
		First Named Inventor Brian Lentricchia
		Group Art Unit Not-Yet-Assigned
		Examiner Name Not-Yet-Assigned
(use as many sheets as necessary)		Attorney Docket Number 2024738-7030230000
Sheet	1	of 1

U.S. PATENT DOCUMENTS

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FOREIGN PATENT DOCUMENTS

Examiner Signature		Date Considered	
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EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Unique citation designation number. ² As attached to U.S. Patent Documents. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST. 3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. **DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO:** Assistant Commissioner for Patents, Washington, DC 20231.

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PATENT COOPERATION TREATY

JUN 10 2003

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:
 DUNCAN A. GREENHALGH
 TESTA, HURWITZ, & THIBEAULT, LLP
 HIGH STREET TOWER
 125 HIGH STREET
 BOSTON, MA 02110

PCT

BINGHAM McCUTCHEON LLP

WRITTEN OPINION

(PCT Rule 66)

		Date of Mailing (day/month/year)
		REPLY DUE
Applicant's or agent's file reference		within 1 months/days from the above date of mailing
CYM-036PC		
International application No.	International filing date (day/month/year)	Priority date (day/month/year)
PCT/US02/01430	15 January 2002 (15.01.2002)	15 January 2001 (15.01.2001)
International Patent Classification (IPC) or both national classification and IPC		
IPC(7): C12Q 1/68; C07H 19/00 and US Cl.: 435/6; 536/22.1		
Applicant		
CYM-036PC		
<p>1. This written opinion is the <u>first</u> (first, etc.) drawn by this International Preliminary Examining Authority.</p> <p>2. This opinion contains indications relating to the following items:</p> <ul style="list-style-type: none"> I <input checked="" type="checkbox"/> Basis of the opinion II <input type="checkbox"/> Priority III <input type="checkbox"/> Non-establishment of opinion with regard to novelty, inventive step and industrial applicability IV <input type="checkbox"/> Lack of unity of invention V <input checked="" type="checkbox"/> Reasoned statement under Rule 66.2 (a)(ii) with regard to novelty, inventive step or industrial applicability, citations and explanations supporting such statement VI <input type="checkbox"/> Certain documents cited VII <input type="checkbox"/> Certain defects in the international application VIII <input type="checkbox"/> Certain observations on the international application <p>3. The applicant is hereby invited to reply to this opinion.</p> <p>When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension. See rule 66.2(d).</p> <p>How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.</p> <p>Also For an additional opportunity to submit amendments, see Rule 66.4. For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis. For an informal communication with the examiner, see Rule 66.6</p> <p>If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.</p> <p>4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: <u>15 May 2003 (15.05.2003)</u>.</p>		
Name and mailing address of the IPEA/US Commissioner of Patents and Trademarks Box PCT Washington, D.C. 20231 Facsimile No. (703)305-3230		Authorized officer Jezia Riley Telephone No. 703-308-0196

Form PCT/IPEA/408 (cover sheet)(July 1998)

(CYM-036)
SUPPL. IDS - US

DOCKETED

3-29-03

Recd. Writ. Opin.
DOCKETED

15-MAY-03 FIN/M

PATENT COOPERATION TREATY

From the
INTERNATIONAL PRELIMINARY EXAMINING AUTHORITY

To:
DUNCAN A. GREENHALGH
TESTA, HURWITZ, & THIBEAULT, LLP
HIGH STREET TOWER
125 HIGH STREET
BOSTON, MA 02110

PCT

WRITTEN OPINION

(PCT Rule 66)

		Date of Mailing (day/month/year)	28 MAY 2003
Applicant's or agent's file reference		REPLY DUE	
CYM-036PC		within 1 months/days from the above date of mailing	
International application No.	International filing date (day/month/year)	Priority date (day/month/year)	
PCT/US02/01430	15 January 2002 (15.01.2002)	15 January 2001 (15.01.2001)	
International Patent Classification (IPC) or both national classification and IPC			
IPC(7): C12Q 1/68; C07H 19/00 and US Cl.: 435/6; 536/22.1			
Applicant			
CYM-036PC			

1. This written opinion is the first (first, etc.) drawn by this International Preliminary Examining Authority.
2. This opinion contains indications relating to the following items:

- I Basis of the opinion
- II Priority
- III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV Lack of unity of invention
- V Reasoned statement under Rule 66.2 (a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI Certain documents cited
- VII Certain defects in the international application
- VIII Certain observations on the international application

3. The applicant is hereby invited to reply to this opinion.

When? See the time limit indicated above. The applicant may, before the expiration of that time limit, request this Authority to grant an extension. See rule 66.2(d).

How? By submitting a written reply, accompanied, where appropriate, by amendments, according to Rule 66.3. For the form and the language of the amendments, see Rules 66.8 and 66.9.

Also For an additional opportunity to submit amendments, see Rule 66.4.
For the examiner's obligation to consider amendments and/or arguments, see Rule 66.4 bis.
For an informal communication with the examiner, see Rule 66.6.

If no reply is filed, the international preliminary examination report will be established on the basis of this opinion.

4. The final date by which the international preliminary examination report must be established according to Rule 69.2 is: 15 May 2003 (15.05.2003).

Name and mailing address of the IPEA/US Commissioner of Patents and Trademarks Box PCT Washington, D.C. 20231 Facsimile No. (703)305-3230	Authorized officer Jezia Riley Telephone No. 703-308-0196
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WRITTEN OPINION

International application No.

PCT/US02/01430

I. Basis of the opinion1. With regard to the elements of the international application:^{*}

the international application as originally filed

the description:
pages 1-22 _____, as originally filed
pages NONE _____, filed with the demand
pages NONE _____, filed with the letter of _____

the claims:
pages 23-26 _____, as originally filed
pages NONE _____, as amended (together with any statement) under Article 19
pages NONE _____, filed with the demand
pages NONE _____, filed with the letter of _____

the drawings:
pages NONE _____, as originally filed
pages NONE _____, filed with the demand
pages NONE _____, filed with the letter of _____

the sequence listing part of the description:
pages 1-3 _____, as originally filed
pages NONE _____, filed with the demand
pages NONE _____, filed with the letter of _____

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.
These elements were available or furnished to this Authority in the following language _____ which is:

the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
 the language of publication of the international application (under Rule 48.3(b)).
 the language of the translation furnished for the purposes of international preliminary examination (under Rules 55.2 and/or 55.3).

3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the written opinion was drawn on the basis of the sequence listing:

contained in the international application in printed form.
 filed together with the international application in computer readable form.
 furnished subsequently to this Authority in written form.
 furnished subsequently to this Authority in computer readable form.
 The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
 The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

the description, pages NONE _____
 the claims, Nos. NONE _____
 the drawings, sheets/fig NONE _____

5. This opinion has been drawn as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).

* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this opinion as "originally filed."

WRITTEN OPINION

International application No.
PCT/US02/01430**V. Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement****1. STATEMENT**

Novelty (N)	Claims <u>30-35</u>	YES
	Claims <u>1-29 and 36-40</u>	NO
Inventive Step (IS)	Claims <u>30-35</u>	YES
	Claims <u>1-29 and 36-40</u>	NO
Industrial Applicability (IA)	Claims <u>1-40</u>	YES
	Claims <u>NONE</u>	NO

2. CITATIONS AND EXPLANATIONS

Claims 1-29 and 36-40 lack novelty under PCT Article 33(2) as being anticipated by Van Ness US 5,124,444.

The reference relates to compositions and assay methods for the extraction and hybridization of nucleic acids. In particular this invention relates to compositions and methods to extract nucleic acids from cells in complex biological samples or specimens. The method is based on the use of the chemical family of compounds termed lactams, preferably pyrrolidones, which promote nucleic acid base pairing and which are effective in the extraction and purification of nucleic acids. The extraction solution will contain standard buffers and detergents to promote lysing of cells. A buffer such as sodium citrate, Tris HCl, PIPES or HEPES, preferably Tris-HCl at a concentration of about 0.05 to 0.1M can be used. The extraction solution will typically also contain about 0.05 to 0.5 % of an ionic or nonionic detergent, such as sodium dodecylsulfate (SDS) and between 1 to 10 mM EDTA. To recover total nucleic acid from GnSCN-solubilized bacterial cells, cells were lysed in 100 microliters of 3M GnSCN, 50 mM Tris pH 7.6, 25 mM EDTA and 2% Sarkosyl. 100 microliters of ethylene glycol was then added to the lysate followed by 500 microliters of phenol and 30% microliters of 1% SDS, 50 mM Tris pH 7.6, 25 mM EDTA and 0.05M NaCl.

----- NEW CITATIONS -----

US 5,124,444 A (VAN NESS et al) 23 June 1992, see entire document.

WRITTEN OPINION

International application No.
PCT/US02/01450

Supplemental Box

(To be used when the space in any of the preceding boxes is not sufficient)

TIME LIMIT:

The time limit set for response to a Written Opinion may not be extended. 37 CFR 1.484(d). Any response received after the expiration of the time limit set in the Written Opinion will not be considered in preparing the International Preliminary Examination Report.